

## REMARKS

Claims 1-16 are pending in the present application. Reconsideration is respectfully requested in view of the following remarks.

1. **Rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,284,037 to Sapper, hereafter “Sapper”, in view of CA 2,154,818 to Bergfried et al., hereafter “Bergfried”.**

The Office Action provides, as reasons for the rejection, only the statement “as generally set forth in the previous office action mailed 03/23/2009.” [sic, mailed 12/24/2008?] 07/22/2009 Office Action page 2, lines 5-7.

Accordingly, Applicants will refer to the previous office action. It states:

Sapper discloses an additive for coating formulation with binder used in basecoat materials comprising a nonassociative rheology stabilizer such as exemplified Viscalex HV30 nonassociative thickener...aluminum pigment, water, polypropylene glycol as a nonionic surfactant, mixed with a polyurethane binder (col. 4, lines 25-65). Sapper further teaches the use of tertiary amine compounds such as dimethylethanolamine to control pH...The amounts of aluminum, nonassociative thickener, and nonionic in the exemplified coating composition overlap with the claimed amount in the coating composition of claim 13.

12/24/2008 Office Action page 3, para. 3.

The Office Action concedes that Sapper does not disclose preparing a pigment paste without binder comprising metallic pigment, nonassociative rheology stabilizer, nonionic surfactant, and amine compound. 12/24/2008 Office Action page 4, para. 1.

The Office Action states, however, that the secondary reference, to Bergfried, discloses a pigment concentrate comprising a pigment, a polyacrylate-based thickener, a nonionic surfactant, an amine, and water, wherein the pigment paste is added to a binder resin. 12/24/2008 Office Action page 4, para. 2.

The Office Action alleges that, given the teachings of Sapper and Bergfried, “it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition.”

12/24/2008 Office Action page 4, para. 3

Applicants appreciate the detailed basis for rejection. However, Applicants must respectfully but strongly disagree. Applicants respectfully submit that the present claims are patentable over the combination of Sapper and Bergfried, for the following reasons.

*1. Sapper, which teaches a composition for a coating composition, cannot teach the present paste composition.*

The coating composition of Sapper does not need to be made from a paste. In fact, there is no teaching that was made from a paste. Even assuming arguendo that it was made from a paste, Sapper does not disclose the composition of the paste or the relative amounts of the components of any paste. Accordingly, Applicants respectfully submit that Sapper has no patentable relevance to the patentability of the present claims to a paste.

As stated in Applicants' response of March 23, 2009, Sapper is directed to the addition of a polymer dispersant additive to a coating material that contains 0.2 percent aluminum pigment in the examples. Obviously, such a coating material is not a paste. Therefore, Sapper does not remotely teach or suggest a metal pigment paste that solves the problem of long-term stability.

The polymer dispersant additive of Sapper comprises a small amount of (i) a specified acrylate polymer and (ii) a nonassociative stabilizer. Abstract. The nonassociative stabilizer can be Viscalex HV 30, as noted by the Examiner. However, neither the additive nor the coating formulation is a metallic paste.

The purpose of Sapper's additive is to improve the stability of a coating formulation, not a paste. Col. 1, lines 30-34. In particular, Sapper states:

The polymer dispersions used in accordance with the invention are outstandingly suitable as viscosity adjusters and as a stabilizer for coating formulations, especially for aqueous coating formulations, in order to improve the rheological stability of these coating formulations....The polymer dispersion used in accordance with the invention has been found particularly suitable as an addition to coating materials, such as metallic paints, for automotive finishing. [Emphasis added, col. 1, line 53, to col. 2, line 6.]

Thus, the nonassociative thickener of Sapper is not used as a thickener for a metallic paste, but for a final coating composition, which is comparatively very thin and greatly diluted, as indicated in present claim 13 or the example on page 20 of the present application, in which 3% of the metal pigment is contained in the coating material, as compared to 22% in the paste.

Furthermore, it is important to note that Sapper teaches away from the present paste composition. In particular, Sapper actually teaches that the nonassociative thickener is not part of a metallic paste. Sapper states, “The polymer dispersions can be added to any desired known aqueous coating formulations [i.e., not to a paste], such as aqueous formulations based on polyurethane, on polyester, on acrylate or on epoxy, and to aqueous 2-component coating systems based on isocyanate.” Col. 3, lines 33-37. This is clearly inconsistent with the present claims, even assuming arguendo that Sapper did use a metallic paste to make a paint, of which there is no evidence.

The fact that Sapper teaches nothing about a metallic paste is further illustrated by the Examples in Sapper. Again, Sapper, in fact, adds the Viscalex HV30 to a stored paint, not to a metallic paste. Col. 4, line 61. Furthermore, claim 1 of Sapper claims a method of stabilizing an aqueous coating formulation which in claim 2 is described as selected from the group consisting of one-component waterborne coating formulations, two-component waterborne coating formulations, and physically drying waterborne coating formulations.

Thus, Applicants respectfully submit that the reference, i.e., Sapper, as a whole, does not teach or suggest what the Examiner is concluding, i.e., Applicants' pigment paste. Sapper does not teach, suggest, motivate, or even allude to an aqueous metallic paste, let alone one that is free from binders and grinding resins such as the one in Applicants' independent claim 1. Sapper does not provide any basis for arriving at Applicants' independent claim 1. Rather, Sapper specifically teaches away from adding a nonassociative thickener to a paste composition, let alone a metallic paste that does not have a binder or grinding resin. In contrast, the present invention is directed to a metallic paste that cannot be used as a coating, but only as a component for preparing a coating, in which a specific nonassociative thickener is used without a binder or grinding resin and

in which the amounts of each component are carefully selected to obtain, in combination, greatly increased stability that is unexpected and unpredictable.

In this regard, it is held that "[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). For at least this reason, Applicants respectfully assert that Sapper cannot be used as a prior art reference because it teaches away from the present independent claim 1, i.e., Sapper teaches that the associative thickener is not added to a paste, but rather to the final coating composition. These deficiencies are not, and cannot be, remedied by Bergfried.

*2. Bergfried, which teaches a paste composition, teaches away from the present paste composition in terms of ingredients.*

Turning now to Bergfried, the Office Action incorrectly implies that Bergfried teaches a metallic paste. The Examiner equates Bergfried's electrically conductive pigment based on metal oxides to Applicants' metallic pigment. Applicants respectfully submit, however, that this alleged equivalency is improper because it is generally known in the art that when it comes to aqueous solution behavior and stability, an electrically conductive pigment based on metal oxides is substantially different from a metallic pigment. The courts have held that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art...." *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

Thus, although Bergfried is indeed directed to a pigment paste, it is not directed to a metallic paste. In contrast, the present invention on page specifically states:

By metal pigments are meant finely divided metallic pigments, usually in the form of flakes. A distinction is made between metallic pigments and those metal effect pigments which fulfill functional roles, e.g. in corrosion protection, as conductive pigments....[Emphasis added.]

Page 8, lines 28, to page 9, line 5.

Further, on page 9 of the specification, there is a Table further illustrating the distinction between, on the one hand, metallic pigments, which include aluminum

pigments and gold bronzes and, on the other hand, functional pigments such as conductive pigments.

In contrast, Bergfried relates to “an aqueous concentrate of an electrically conductive, ultrafine pigment” that can be used in an antistatic coating. Page 1, lines 1-2. Bergfried teaches “electrically conductive pigment, tin (IV) oxide, doped with antimony and/or fluoride, which optionally is coated onto a supporting pigment (rutile, barium sulfate, mica, etc.).” Page 3, lines 28-31. This is clearly not a metallic material.

The Examiner has repeatedly asserted that Sapper's pigments and Bergfried's pigments are equivalent because they are both conductive. (See, for example, 7/10/2008 Advisory Action, page 2, second paragraph). Applicants respectfully submit that this assertion is without reasonable basis because, on the contrary, it is well known that many aspects of a compound and/or particle are critical in the ability for a compound and/or particle to disperse in a medium, such as polarity, particle size, surface charge, geometry, swellability, etc. The Examiner has not provided any reasonable basis as to why two chemically distinct species would be equivalent in dispersion behavior or stability based on their conductivity. The Examiner has not provided any technical or factual basis to support this assertion. For example, there is no reason that one of ordinary skill would use the same materials, and amounts thereof, to stabilize such completely different kinds of materials. .

*3. Bergfried, which teaches a paste composition, does not teach the relative amounts of the ingredients in the present invention, even assuming arguendo that the pigments were equivalent.*

The Office Action states:

With respect to the amount of aluminum pigment, while Sapper discloses an amount of aluminum pigment in a coating composition less than presently claimed and Bergfried discloses an amount of pigment more than presently claimed, it is considered that the amount of pigment is determined by the desired metallic effect...[Emphasis added.]

12/24/2008 Office Action page 4, para. 4.

In particular, the examples on page 8 of Bergfried (inventive formulations 2, 4, and 5) contain 42%, 50%, and 54% of tin oxide particles and 4%, 5%, and 5%, respectively, of a polymer excluded by the present claims.

It is apparent that Bergfried is using more pigment by using more of a polymer dispersant, whereas Applicant has found that greater stability is obtained at a lesser concentration by not using the polymer dispersant at all. Furthermore, Bergfried uses proportionately more thickener than in the present application.

There is no teaching or suggestion in the cited prior art to use 15 to 40% by weight of at least one metal pigment, preferably 22%, in combination with 0.45% to 0.75% of a specified non-associative thickener, as required by present claim 1. In contrast, Bergfried requires 40-60% of an “electrically conductive pigment based on metal oxides” in combination with an amount of thickener that can easily be outside Applicants’ claimed range and, in fact, is considerably outside Applicants’ claimed range in Bergfried’s examples.

Applicants respectfully submit that to find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” [Emphasis added.] *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Applicants respectfully submit that no such reason has been identified by the Examiner as to why one with ordinary skill in the art would change Bergfried’s 40 to 60% to Applicants’ 15 to 40% by weight and, at the same time, lower the relative amounts of the thickener and amine.

Moreover, it is important to note that Applicants are not arguing merely that the amount of each ingredient, in combination, in the metallic paste is novel and unexpected, but rather that the stability obtained from the novel composition is surprising, which is evident by comparing the demonstrated stabilities of only 10 hours achieved by Bergfried for a paste comprising tin oxide.

*4. Bergfried, which teaches a paste composition, does not teach exclusion of a dispersing resin, but rather its necessity.*

Bergfried does not teach the present invention for still another reason. In particular, Bergfried fails to teach the requirement of the present invention (as recited in claim 1) that “the aqueous pigment paste is free from binders, including grinding resins used for dispersing pigments.” The present specification states:

The pigment paste of the invention...was substantially free from organic solvents, binders, and grinding resins. Additionally, only comparatively small amounts of additives were needed. Despite this, the pigment paste of the invention was surprisingly stable, transportable, and storable....

Page 6, lines 1-7.

Applicants submit that Bergfried does indeed use a binder or grinding resin used for dispersing pigment. As indicated in claim 1 of Bergfried, the composition of Bergfried includes 2 to 4.9 percent of a terpolymeric, anionic polyacrylate, which satisfies the definition of a binder and grinding resin, as discussed at length in Applicants' previous amendment. Bergfried states, on page 2, as follow:

Typical dispersing additives for aqueous systems are surface active, anionic, cationic or nonionic substances, which have a low molecular weight...The use of polyacrylates of low molecular weight as dispersants for pigments in aqueous coating is also known....However, adequate stabilization of the aqueous pigment concentrates cannot be achieved according to this state of the art.

Thus, Bergfried teaches away from the present invention by specifically stating, not only that not just any polyacrylate dispersant is sufficient, but also that a particular kind of polyacrylate dispersant is required. In fact, based on the experimental results shown in the table on page 8 of Bergfried, a certain type of terpolymer binder (dispersing resins 2 or 4) is required, compared to the dispersing resins of formulations 1, 3, and 6. Finally, unless this kind of binder is used, the compositions are unstable after only 1 hour, whereas with the binder required by Bergfried, and excluded by the present invention, the stability is shown to be achieved for merely 10 hours, as compared to 3 months achieved using the present invention, as stated on page 2 of the present specification and as required by present claim 1. Clearly, Bergfried teaches away from the present invention with respect to the binder or dispersing (grinding) resin.

As pointed out in Applicants' previous amendments, the term "grinding resin" is not a process limitation with respect to grinding, but rather a compositional limitation. Therefore, the composition does not require grinding, although a metal pigment paste might normally use grinding. One of ordinary skill in the art would know, however, that grinding resins can be used for dispersing pigments irrespective of grinding, or they can also be used for a dispersing effect in combination with grinding. This is clearly stated by claim 1, which recites that the grinding resin is "used for dispersing pigments."

Furthermore, it is respectfully submitted that there is no requirement in the art that a "grinding resin" is only used for "grinding," as appears to be assumed by the Examiner. Applicants disclose, for example, that "grinding resins are used for dispersing pigments," and that "they are binders whose capacity for dispersing pigments is particularly high." (Application as filed, page 7, line 24, to page 8, line 3). Therefore it is respectfully asserted that a grinding resin is a resin that can be used for stabilizing a pigment dispersion and there is no grinding requirement in the present composition claim, inherently or otherwise.

This is further affirmed by the prior art, as would be appreciated by the skilled artisan, such as United States Patents No. 6,476,170 and 6,630,211 to Roth and Baumgart, respectively. Roth, for example, discloses that "[i]n use, the [grinding] resins are suspended in water to form a solution and made into a dispersion, known as a latex, by neutralizing them with a base [...]" (Roth, column 1, lines 24-27). Nowhere does Roth require any "grinding". Similarly to Roth, Baumgart does not require any "grinding." Applicants respectfully assert that Bergfried's grinding resin is equivalent to that of Roth and Baumgart in terms of its use, i.e., to stabilize a dispersion, among others.

Furthermore, the terpolymer of Bergfried is, in fact, used for grinding a pigment. Bergfried uses milling (grinding) or its equivalent to divide pigment agglomerates (page 4, lines 13-22). Thus, any way one looks at it, the terpolymer of Bergfried is a grinding resin, whether of the type used for dispersion alone or of the type used for both grinding and dispersion.

In view of the above, Bergfried does not remotely teach or suggest the invention of Applicants' independent claim 1, reciting a metallic paste free from binders and

dispersing resins, also referred to as grinding resins. For at least this reason, Bergfried (like Sapper), in fact, teaches away from the claimed invention.

*5. The combination of Bergfried and Sapper cannot correct the deficiencies of either of them alone.*

As indicated above, Sapper does not teach a paste, and Bergfried teaches a paste that does not teach the composition of the present paste. Since Sapper is not directed to a paste, there would be no motivation to use the teachings of Sapper to modify the paste of Bergfried. Conversely, since Bergfried is directed to a paste, there is no reason that Bergfried would teach a modification to the non-paste coating composition of Sapper to obtain the presently claimed paste.

*6. Neither Bergfried nor Sapper alone or in combination teach a paste that obtains the claimed properties of the present paste composition.*

The Office Action states that, although the combined teaching of Sapper and Bergfried are silent about whether the composition is stable, transportable and storable for up to three months as set forth by Applicants' independent claims 1 and 16, it would be expected that the composition of the combined teachings of Sapper and Bergfried "have similar properties since the composition's property is determined by the constituents of the composition absent any evidence to the contrary." 12/24/2008 Office Action page 4, last paragraph, to page 5, first paragraph.

However, neither Sapper nor Bergfried teach the present composition, so the properties are not inherent in anything in Bergfried or Sapper, alone or in combination.

The metallic paste of the present invention can be storable for up to three months without settling and without the formation of inhomogenities or coagulum (page 6, lines 8-11 and working example on page 20, lines 14-17). Significantly, there is no evidence that the metal oxide paste of Bergfried is stable for a period greater than about 10 hours. In fact, small variations in the paste formulation of Bergfried (as shown by Comparative Examples 1 and 6) result in the composition becoming unstable in less than one hour.

Yet the difference between Examples 2, 4, and 5 of Bergfried from the unstable Comparative Examples 1, 3, and 6 is less than the difference between Examples 2, 4, and 5 of Bergfried and the composition of the present invention. Thus, the present inventive properties are wholly unpredictable, based on the evidence in Bergfried.

The Applicant respectfully submits that the Final Office Action has not responded to Applicants arguments above. Furthermore, the Final Office Action is wrong as a matter of law and wrong on the facts, as further pointed out in the following discussion of the Examiner's "Response to Arguments."

### **Response to Arguments**

*1. The Final Office Action, after noting that Sapper is not directed to a paste, incorrectly argues that a paste composition is the same as the order of the mixing of a final paint composition.*

The Final Office Action states:

It would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition. While Sapper discloses mixing all of the ingredients, it is *prima facie* obvious to change the mixing order since the end product is the same.

07/22/2009 Office Action page 2, last paragraph.

However, this is not relevant to the invention. The invention is directed to a paste, not to an order of mixing a paint. Clearly, the order of mixing a paint does not teach a stable paste composition. Changing the order of mixing in Sapper does not produce a stable paste, but a change in the order of mixing. Furthermore, there are no grounds for the Examiner to pick and choose from the ingredients in Sapper to compose a paste, particularly when Sapper teaches no paste. Hence, this response, in the Final Office Action, is hindsight and speculation.

*2. The Final Office Action incorrectly states that a paste composition is obvious merely because a coating composition that contains the same ingredients is obvious. This ignores the art of paste compositions.*

The Final Office Action states:

The Examiner respectfully submits that Sapper discloses the instant application's end product (claim 13's product). [07/22/2009 Office Action page 3, paragraph 2.]

Applicant respectfully submits that the fact that Sapper discloses the instant application's end product is entirely irrelevant to the question of the composition of the paste used to make the final composition or, as in claim 13, a process of making a final coating composition using a particular paste composition. The paste and final coating compositions are separate and distinct formulations; one does not teach the other. Typically, various and diverse paste compositions can be used to make the same conventional paint, but that does not make the various possible paste compositions automatically obvious, because clearly their various stabilities might range from unacceptable to poor to good. It cannot be reasonably asserted that a final coating composition automatically teaches whatever paste composition can be used to make the final coating composition.

*3. The Final Office Action incorrectly states that Bergfried discloses a pigment composition without binder or grinding resin.*

The Final Office Action states:

...Bergfried disclose a pigment composition without a binder....Furthermore, Bergfried disclose a pigment composition without a binder....The Examiner respectfully submits that Bergfried discloses a pigment concentration without a binder and it is used to show that the paint can be made by mixing binders and the composition comprising pigment without binder.

07/22/2009 Office Action page 3, paragraphs 2-3.

Contrary to the repeated assertions by the Examiner, Bergfried absolutely requires 2 to 5% of a terpolymeric, anionic polyacrylate, which is both a binder and a grinding resin, for the reasons stated above. The Final Office Action has provided no reason to

dispute this fact. The Final Office Action merely states that Bergfried mentions that binders such as PVC, polyvinyl acetate, polyester, polyurethane or polyacetate can be later mixed with the paste. However, the later inclusion of an additional binder to the paste of Bergfried does not mean, nor in the least implies, that the polyacrylate terpolymer, that is already in the paste, is not present or is not a binder or grinding resin.

4. *The Final Office Action incorrectly assumes metallic particles are equivalent to non-metallic particles with respect to their dispensability or stability in a paste.*

The Office Action states:

The applicant argues that the Examiner implies that Bergfried discloses a metallic paste....The teaching of Sapper discloses a metallic pigment-aluminum pigment, which is also conductive.

07/22/2009 Office Action page 3, paragraph 3.

As stated above, the conductivity of a pigment in the paste is not relevant to the purpose or the relevant properties of the present pigment paste. It is completely unclear why conductivity of a pigment has any relevance to the present invention, its stability or storability, or the asserted obviousness.

5. *The Final Office Action fails to respond to the fact that the prior art does not teach the combination of presently claimed ranges of ingredients, which is highly significant for a stable paste formulation.*

The Examiner notes that the range for the amount of pigment per se, in the present claims, overlaps the very bottom of the range recited in Bergfried. However, the Examiner fails to appreciate that the combination of ranges of all of the five components of the presently claimed paste is not taught by Bergfried.

It would require a selection from five different ranges in Bergfried to obtain the ranges of the corresponding components in the presently claims. For example, Bergfried claims 40 to 60% of pigment; one would need to choose 40%, which can be viewed as a selection of 1 out of 20 different amounts. Bergfried claims 0.1 to 4.9% of the amine,

compared to 0.1 to 0.4 percent in the present claims; this can be viewed as a selection of 7 out of 100 different amounts (“0.44 minus 0.1 divided by 4.9 minus 0.1”). Bergfried claims a range of 0 to 2.0% of a thickener, compared to 0.45 to 0.75% in the present claims; this can be viewed as a selection of 15 out of 100 different amounts.

To multiply the probabilities of these selected amounts together would result in a total probability of 0.05 percent (5 out of 10,000) with respect to Bergfried obtaining a composition, as a whole, within the combination of ranges of applicants' ingredients (not to mention conflicting ingredients). Thus, it is not at all surprising that the combination of amounts of each ingredient in the examples in Bergfried, in fact, are very different than those in the examples in the present application. The Examiner provides no reason for selecting a combination of amounts from the various ranges in Bergfield to improve the stability of a paste composition, as a whole, according to the present claims.

This is a result of the fact that Bergfried is quite obviously directed, as a practical matter, to pastes that have a higher concentration of pigment. It follows from the above, therefore, that Bergfried does not teach the relative amounts of ingredients in the present composition.

*6. The Final Office Action incorrectly states that the prior art teaches the same stability as Applicant's paste*

The Final Office Action states:

The Applicant argues that the instant application's composition is stable. The Examiner respectfully submits that the ability of the paste to be stored up to three months is determined by the constituents of the composition, the claimed stability would be necessarily followed from the teaching of Sapper and Bergfried.

07/22/2009 Office Action page 3, last paragraph.

This is contrary to the facts, as stated above. Sapper does not teach a paste, so has nothing to say about the stability of a paste. Bergfried teaches a stability of 10 hours, with the possibility of slight sedimentation, not three months stability. Hence, factually the claimed stability would not follow from Sapper or Bergfried or the combination.

*7. The Final Office Action incorrectly refuses to give any patentable weight to the recited stability and storability of the paste.*

The Final Office Action states:

Furthermore, the recitation the paste is stored up to three months has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely asserts the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but instead, the process or structural limitations are able to stand alone.

07/22/2009 Office Action page 4, first paragraph.

Applicants respectfully submit, however, that there is no process recitation in the claim that the paste "is stored up to three months," and there is no assertion of "the purpose of a process or the intended use" of the composition. Rather, a clearly relevant capability or property of a claimed composition is positively stated.

The MPEP 2111.02 states that the determination of whether a preamble limits a claim is on a case-by-case basis in lights of the facts of each case. The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966.

In Poly-America LP v. GSE Lining Tech. Inc., 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004), the court stated that "a '[r]eview of the entirety of the '047 patent reveals that the preamble language relating to 'blown-film' does not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim." [Emphasis added.]

Similarly, the present invention claims, "An aqueous pigment paste that is stable transportable, and storable for up to three months. [Emphasis added.] This is clearly a functional limitation in terms of the capacity of the paste. See Ricoh Co., Ltd. V. Katun

Corp., 486 F. Supp. 2d 395 (D.N.J. 2007) in which the court construed a preamble phrase as describing a limiting “capability.” The court stated, “the Federal circuit has clearly held that limitations may be functional and has never stated that a limitation articulated in functional terms may not appear in a preamble....This Court has already found that the preamble is necessary to give life, meaning, and vitality to the claim.”

See also Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d at 808-09, 62 USPQ2d at 1785. (“[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.” [Emphasis added.] This is particularly the case here. The Applicants have used the limitation to distinguish from the prior art. Furthermore, the final rejection was the first time that Examiner stated that the limitation in question has no patentable weight. In any case, Applicants would be happy to move the phrase in issue outside the preamble of the claim if the Examiner were to agree to allow the claim.

### **Conclusion**

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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Tuesday, September 22, 2009  
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